



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,404	09/07/2006	Antoni Torrens Jover	284362US0PCT	3482
22850	7590	07/24/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER MCDOWELL, BRIAN E	
			ART UNIT	PAPER NUMBER
			1624	
			NOTIFICATION DATE	DELIVERY MODE
			07/24/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No. 10/566,404	Applicant(s) TORRENS JOVER ET AL.	
	Examiner BRIAN MCDOWELL	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/6/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) 15-17, 20-41, 58-60, 64-66 and 68 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 18, 19, 42-56, 61-63 and 69 is/are rejected.
- 7) ☒ Claim(s) 14, 57, and 67 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

/BEM/

DETAILED ACTION

Status of Claims

Claims 1-69 are pending in the instant application. Claims 15-17, 20-41, 58-60, 64-66, and 68 are withdrawn from consideration. Claims 67-69 are new claims.

Status of Restriction Requirement

Newly submitted claim 68, directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Said claim is drawn to a method of treatment while applicant's elected invention is drawn to compounds of the formula I (group I).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 68 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Priority

Applicant's submission of a translated copy of the foreign priority document, see Remarks, filed 5/6/2009, with respect to the Non-Final Office Action mailed 2/6/2009, has been fully considered. Consequently, the application receives the foreign priority date of 7/30/2003.

Status of Claim Objections

Applicant's amendment of claims 4-14, 18, 19, 45-57, 61-63, see Remarks, filed 5/6/2009, with respect to the Non-Final Office Action mailed 2/6/2009, has been fully considered and the objection has been overcome.

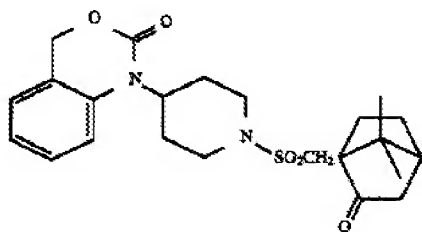
Status of Rejections

35 USC § 102

The 102 rejection of claims 1-3 and 42-44 is maintained for the reasons stated on record and herein.

Applicant's arguments regarding claims 1-3 and 42-44, see Remarks, filed 5/6/2009, with respect to the Non-Final Office Action mailed 2/6/2009, have been fully considered but are not found persuasive.

Bock *et al.* disclosed the following compound:



Art Unit: 1624

wherein $R^{1-9} = H$ and W = a condensed cycloaliphatic radical that is bonded by an unsubstituted alkylene group. The condensed cycloaliphatic radical is substituted with alkyl and keto groups that read on the aforementioned claims and are therefore anticipated. This compound falls within the limitations of claim 1 (see page 4, lines 15-17).

35 USC § 112 (1st Paragraph)

Applicant's amendment of claim 1 regarding the rejection of claims 1-3 and 42-44, see Remarks, filed 5/6/2009, with respect to the Non-Final Office Action mailed 2/6/2009, has been fully considered and the rejection has been overcome.

New Objections and Rejections

Claim Objections

Claim 14 is objected to because of the following formalities:

At the end of the claim it should read "or a corresponding salt thereof" and not "or a corresponding salts thereof". Please correct.

Claim 57 is objected to because the species are embedded in a table. Please remove said table and list the compounds independently by their respective names.

Claim 67 is objected to because of the following formalities:

At the end of the claim, a comma is needed after "and" where the claim reads "and 3-(2-Methyl-4-pyrimidinyl)-". Please correct.

Claim Rejections - 35 USC § 112 (2nd Paragraph)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5, 46, 56, and 69 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the instant claims, the examiner can not readily interpret what substituents are encompassed by variable W. The claims are convoluted and one of ordinary skill can not interpret from the way the claims are written which moieties are supposed to serve as substituents on variable W and which moieties can actually serve as W itself. For instance in claim 69, are phenyl groups supposed to be embraced by the term "alkyl

Art Unit: 1624

radical”? The examiner suggests that the claims be rewritten in a clear format where the definitions of W can be readily interpreted.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4, 6-13, 18, 19, 45, 47-55, and 61-63 are rejected under 35 U.S.C. 102(b) as being anticipated over Bock *et al.* (US Patent 5,665,719-mentioned in International Search Report).

This rejection was made for the reasons previously stated above in this office action.

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

Art Unit: 1624

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN MCDOWELL whose telephone number is (571)270-5755. The examiner can normally be reached on Monday-Thursday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B.E.M./
Examiner, AU 1624

**/James O. Wilson/
Supervisory Patent Examiner, AU 1624**